

Response

Applicant: Daniel J. McGurran et al.

Serial No.: 09/872,532

Filed: June 1, 2001

Docket No.: M120.221.101 / 56763US002

Title: COLOR STABLE PIGMENTED POLYMERIC FILMS HAVING DYES FOR COLOR ADJUSTMENT

REMARKS

The following remarks are made in response to the Office Action mailed October 5, 2005. In the Office Action, claims 26 and 27 were rejected under 35 U.S.C. § 112, first paragraph. In addition, claims 1, 2, 10, 11, 13-19, 21, 24, and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by McGurran et al., U.S. Patent No. 6,569,517 ("McGurran"), and claims 22 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McGurran in view of Weaver et al., U.S. Patent No. 6,248,816 ("Weaver").

With this Response, claims 1, 2, 10, 11, 13-19, and 21-27 remain pending in the application and are presented for consideration and allowance.

Miscellany

Claim 27 was newly presented in an Amendment mailed January 25, 2005. The Examiner rejected claims 26 and 27 35 U.S.C. §112, first paragraph, in a Final Office Action mailed April 19, 2005. In the Amendment and Response mailed July 19, 2005, claim 27 was incorrectly reproduced due to an unintentional transcription error (unintentionally omitting the words "to a substantially neutral gray, and wherein the window film"). With this Response, claim 27 is correctly reproduced in this document to reflect the language of claim 27 as newly presented on January 25, 2005.

Claim Rejections under 35 U.S.C. § 112

Claims 26 and 27 were rejected under 35 U.S.C. §112, first paragraph. The Office Action takes the position that claims 26 and 27 include subject matter that was not disclosed in the Specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed subject matter at the time the application was filed. Applicant respectfully disagrees.

The subject matter of the present invention is directed to color stable films, and claims 26 and 27 are directed to window films. Support for the language of claims 26 and 27, and support for employing the color stable films as window films, can be located throughout the Specification. For example, at page 1, line 14 it is taught that tinted polymeric films can be

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applied to a base transparent substrate such as a window or auto glass pane to provide a neutral color tint to the window or auto glass pane. Additionally, at page 4, line 19, the Specification teaches “still further, the present disclosure provides articles, including pigmented window and auto glass films, that incorporate the above color-staple optical bodies.” It is respectfully submitted that the window and auto glass film disclosure, in combination with other disclosure in the Specification at page 15, lines 15-19, and in original claim 21, would convey to one skilled in the art that the inventors had possession of the claimed window film subject matter at the time the application was filed.

However, to unambiguously clarify the locations where the Specification provides support for the window films recited in claims 26 and 27, the language of the claims is reproduced below and includes reference to certain portions of the Specification as filed particularly pointing out where examples of support for the specific language is located.

Claim 26: A window film (*See*, for example, page 4, lines 18-19) comprising at least one layer (*See*, for example, page 5, lines 15-17) of a cast (*See*, for example, page 6, lines 22-31), oriented (*See*, for example, page 6, lines 30-31), polyester-containing polymer material (*See*, for example, page 5, lines 18-19) having a thickness of between 0.3 and 3 mm (*See*, for example, page 6, lines 27-29), the at least one layer having dispersed therein between 0.02 and 0.5 percent by weight (*See*, for example, page 9, lines 12-15) carbon black particulate pigment (*See*, for example, page 8, lines 15-17) having a mean diameter of no more than 500 nm (*See*, for example, page 8, lines 10-11) and a blue dye (*See*, for example, page 12, lines 6-9; and page 13, lines 18-20) in an amount sufficient to adjust the transmitted color of the window film to a substantially neutral gray (*See*, for example, page 13, lines 18-31; and page 17, line 19-page 18, line 15), and wherein the window film exhibits a transmission of light within a wavelength band of interest with in the visible spectrum of from 5 to 90% (*See*, for example, page 2, lines 22-27) and exhibits an internal haze of less than or equal to 5% (*See*, for example, page 12, lines 1-5).

Claim 27: A window film (*See*, for example, page 4, lines 18-19) consisting essentially of at least one layer (*See*, for example, page 5, lines 15-17) of a cast (*See*, for example, page 6, lines 22-31), oriented (*See*, for example, page 6, lines 30-31), polyester-containing polymer material (*See*, for example, page 5, lines 18-19) having a thickness of between 0.3 and 3 mm (*See*, for

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example, page 6, lines 27-29), the at least one layer having dispersed therein between 0.02 and 0.5 percent by weight carbon black particulate pigment (*See*, for example, page 9, lines 12-15) having a mean diameter of no more than 500 nm (*See*, for example, page 8, lines 10-11) and a blue dye (*See*, for example, page 12, lines 6-9; and page 13, lines 18-20) in an amount sufficient to adjust the transmitted color of the window film to a substantially neutral gray (*See*, for example, page 13, lines 18-31; and page 17, line 19-page 18, line 15), and wherein the window film exhibits a transmission of light within a wavelength band of interest within the visible spectrum of from 5 to 90% (*See*, for example, page 2, lines 22-27) and exhibits an internal haze of less than or equal to 5% (*See*, for example, page 12, lines 1-5).

It is respectfully submitted that the Specification reasonably conveys to skilled artisans that the Applicant had possession of the claimed window film subject matter at the time the application was filed. It is believed that the record demonstrates that the written description requirement under 35 U.S.C. § 112, first paragraph, is satisfied. For this reason, it is respectfully requested that the rejections to claims 26 and 27 under 35 U.S.C. § 112, first paragraph, be withdrawn.

In addition, it is noted that no other rejections to claims 26 and 27 were identified, such that the conclusion is compelled that claims 26 and 27 are allowable. MPEP § 904.02. Notice of the allowance of claims 26 and 27 is respectfully requested.

Claim Rejections under 35 U.S.C. §§ 102 and 103

Claims 1, 2, 10, 11, 13-19, 21, 24, and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by McGurran.

The Office Action takes the position at page 8, lines 4-7 that: “Although McGurran uses the term ‘pigment’ for indanthrone, copper phthalocyanine, and cobalt aluminate these are the same ‘dyes’ used in the instant invention and hence are inherently the same.” Applicant respectfully disagrees, and re-asserts that a “pigment” is not a “dye,” such that all claims are allowable over McGurran. One of skill in the art understands that a pigment is not inherently the same as a pigment.

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Applicant further traverses the rejections of claims 1, 2, 10, 11, 13-19, 21, 24, and 25 under 35 U.S.C. § 102(e) as being anticipated by McGurran because the portions of McGurran cited by the Examiner are applicant's own work. M.P.E.P. § 2132.01; M.P.E.P. § 2136.05. With this Response, a Declaration Of Daniel J. McGurran under Rule 132 is submitted, confirming that the portions of McGurran cited by the Examiner are Applicant McGurran's own work. Thus, it is respectfully submitted that the portions of McGurran relied upon by the Examiner do not qualify as prior art under 35 U.S.C. § 102(e). *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); M.P.E.P. § 2136.05.

Based upon the above, it is respectfully requested that the rejections to claims 1, 2, 10, 11, 13-19, 21, 24, and 25 under 35 U.S.C. § 102(e) as being anticipated by McGurran be withdrawn, and claims 1, 2, 10, 11, 13-19, 21, 24, and 25 be allowed.

Claims 22 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over McGurran in view of Weaver. As a point of reference, claim 22 depends from independent claim 1, and claim 23 depends from independent claim 14. For at least the reasons provided above, then, it is respectfully submitted that claims 22 and 23 are allowable. In addition, it is respectfully submitted that pursuant to 35 U.S.C. §103(c), McGurran does not qualify as prior art for an obviousness rejection. A Statement of Common Ownership is concurrently submitted.

It is respectfully requested that the rejections to claims 22 and 23 under 35 U.S.C. §103(a) as unpatentable over McGurran in view of Weaver be withdrawn, and claims 22 and 23 allowed.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1, 2, 10, 11, 13-19, and 21-27 are in form for allowance; notice to this effect is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h),(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

Any inquiry regarding this Response should be directed to David B. Patchett at Telephone No. (651) 736-4713, Facsimile No. (651) 736-3833, or Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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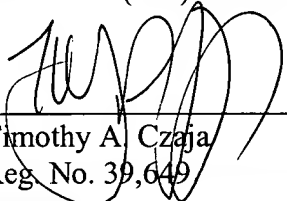
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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5th day of January, 2006

By: 

Name: **Timothy A. Czaja**